

Remarks

Claims 1-2, 4-9, 11-16 and 18-23 were previously pending and stood rejected under 35 USC 103(a). Claim 11 has been amended. Applicants assert that the currently pending claims are in condition for allowance as set forth more fully below.

103 Rejections

Claims 1, 2, 4-9, 11-16, and 18-23 stand rejected under 35 USC 103(a) as being anticipated by Epler (US Pat 5,825,867) in view of Leung (US Pat 6,005,870) and further in view of Ferris (US Pat 6,704,405). The Examiner has asserted that the combination of Epler and Lueng teach or suggest all of the elements of the claims except playing priority alert signals to the telephone number dialed by the caller but that Ferris teaches - generating distinctive tones for different subscribers using the same telephone number. Applicant's concur that after a close reading of Epler in view of Lueng, the combination merely teaches a standard call waiting signal and does not teach playing for the same telephone number a priority alert signal associated with the priority code provided by the calling party and that is indicative of the level of urgency of the call to interfere with the first communication session and alert the subscriber to the level of urgency of the call as recited, for example, in independent claim 1.

The Office Action proceeds to assert that Ferris discloses a personal dial tone service with personalized call waiting that generates tones for different subscribers using the same telephone number and distinctive tones used in call waiting to identify the caller. (Page 3). Ferris deals with a set of distinctive tones based on the actual subscriber to be contacted at a number. If the subscriber is the called party, the personalized service provides a distinctive alerting signal (i.e. a distinctive ringing or call waiting signal) for that subscriber. (Col. 10, l. 33-39; Col. 17, l. 17-33). Ferris also teaches identifying the caller if provided with the call waiting signal. (Abstract). Ferris does not disclose an urgency based call waiting function.

However, there is no explicit or explicit suggestion, motivation or teaching to combine Ferris with Epler because one of ordinary skill in the art looking for a reference about urgency in call waiting would not look to Ferris since Ferris is for the purpose of identifying who the call is for, not urgency. Thus, one would look to Ferris only if

intending Epler to be a system that identifies who the call is for as opposed to indicating a level of urgency. A reference must provide an explicit or implicit suggestion, teaching or motivation in order to be §103 prior art. (See, *In Re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2D (BNA) 1614 (Fed. Cir. 1999) (Placing a pumpkin face on an orange trashbag not obvious under 35USC§103 without finding of suggestion, teaching or motivation in the reference. Furthermore, an argument based on the theory that “it was obvious to try” fails as an obviousness rejection. *In re Fine*, 837 F.2d 1071, U.S.P.Q.2D 1596 (Fed. Cir 1988).

Furthermore, upon careful reading of all three references there is no suggestion that such a combination would yield the elements of the pending claims with a reasonable chance of success. Those teachings must also have a reasonable chance at success (See, *Brown & Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 229 F.3d 1120, 56 U.S.P.Q.2D (BNA) 1456 (Fed. Cir. 2000). Combining the three references implies that there would be have to be a distinct call waiting tone or a combination of tones for each combination of outside caller and urgency level and called subscriber. There would be no suggestion to make such a combination because such a set of combinations and permutations of tones would be impracticable for a called subscriber to distinguish let alone remember and, as such, would defeat the intended functionality of the combination. The fact that the reference can be combined or modified is not sufficient to establish a prima facie obviousness. (See, *In Re Mills*, 916 F.2d 680; MPEP 2143). To simplify the combinations of tones for the subscriber would require that one or more of the references be modified to eliminate a set of tones which may render the prior art unsatisfactory for its intended purpose. (See, *In Re Gordon*, 733 F.2d 900; MPEP 2143).

Accordingly, the independent claims 1, 7, 11, 15, and 20 are allowable over the combination of Epler, Leung and Ferris. Dependent claims 2, 4-6, 8, 9, 12-14, 16, 18, 19, and 21-23 depend from allowable base claims and are also allowable for at least the same reasons.

Furthermore, amended claim 11 now includes recitations to a processor in communication with the switch, wherein the processor is configured to review a subscriber list containing information associated with the subscriber, wherein the information associated with the subscriber is modifiable at any time by the subscriber via

a computer network, ... wherein the processor verifies that the priority code supplied by the calling party is contained in the subscriber list. Additionally, claim 11 recites be one of a plurality of priority codes previously associated with the telephone number and wherein the instruction from the processor specifies the priority alert signal via a control field. Applicants assert that the references, singly or in combination, fail to disclose these recitations as set forth in claim 11 such that claim 11 and its dependent claims are allowable for at least these additional reasons.

Specifically, with reference to the instruction from the processor specifying the priority alert signal via a control field, Epler fails to do so as Epler specifies the particular telephone number to call to provide the desired distinctive ring. Ferris also fails to address this recitation as Ferris requires that an Intelligent Peripheral provide an instruction to the SSP to look up a profile to then determine what the signal should be, rather than telling the SSP what the alert signal is and thereby further burdening the SSP. Accordingly, claim 11 is allowable over the cited combination for this additional reason.

Additionally, amended claim 15 now recites a method for providing a call waiting priority alert service to a subscriber of a telephone line comprising associating two or more priority codes with a telephone number of the telephone line in a database accessible by a controller, wherein each of the two or more priority codes is associated with a priority level of a plurality of priority levels that represents a degree of urgency, each of the plurality of priority levels is associated with a priority alert signal that identifies the degree of urgency for the subscriber, ...determining at the controller whether the priority code from the calling party matches a priority code of the database, when the priority code matches, determining at the controller the priority alert signal for the priority code, sending an instruction to the switch to play the priority alert signal, wherein a control field of the instruction specifies the priority alert signal to play, and playing by the switch and for the telephone number the priority alert signal specified by the controller of the call to interfere with the first communication session between the subscriber and the third party and to alert the subscriber to the level of urgency of the call. Applicants assert that the references, singly or in combination, fail to disclose these recitations as set forth in claim 15 such that claim 15 and its dependent claims are allowable for at least these additional reasons. Specifically, as stated above for claim 11,

none of the cited references provide for a controller providing an instruction to the switch where the instruction specifies which priority alert signal to be played for the called party.

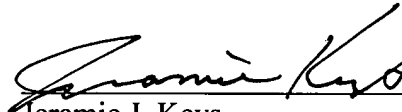
Conclusion

Applicants assert that the application including claims 1, 2, 4-9, 11-16, and 18-23 is now in condition for allowance. Applicants request reconsideration in view of the amendments and remarks above and further request that a Notice of Allowability be provided. Should the Examiner have any questions, please contact the undersigned.

No fees are believed. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025.

Respectfully submitted,

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